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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,043	01/09/2001	Forrest Dockery	DFM-10602/01	6398

7590

07/10/2003

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EXAMINER

MEISLIN, DEBRA S

ART UNIT	PAPER NUMBER
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3723

DATE MAILED: 07/10/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

EC

Office Action Summary	Application No. 09/757,043	Applicant(s) DOCKERY, FORREST	
	Examiner Debra S. Meislin	Art Unit 3723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,7 and 11-23 is/are pending in the application.
- 4a) Of the above claim(s) 19 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,7,11-18 and 21-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 5/22/03 is: a) ☐ approved b) ☒ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

1. The amendment filed May 22, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: spring bias teeth "(Figure 9)" and spring bias pin "(Figure 8)" as added to the paragraph on page 6 that begins on line 4. The original disclosure describes a set screw "40" for figures 8 and 9. Original figures 8 and 9 disclose a set screw as defined in the specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

2. Claim 13 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The "ball lock" was not set forth in the original disclosure and thus constitutes new matter.

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, "spring biased teeth" and "spring biased pin" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

The proposed drawing corrections filed May 22, 2003, are not approved by the examiner. The structure of the various quick disconnect systems, as marked in red, cannot be deciphered due to the lack of clarity of the markings. It is further noted that

the structure marked in red, as best understood, constitutes new matter as not being supported by the original disclosure. The terms "spring biased teeth" and "spring biased pin" are broad terms that do not define the specificity of the red markings. The "ball lock" was not originally disclosed.

It is additionally noted that the original specification and drawings define a set screw "40" for each of the embodiments of figures 7-9. Consequently, figures 7-9 must include a set screw "40" as originally filed.

If applicant wishes to include "spring biased teeth" and a "spring biased pin" in the drawings, it is suggested that additional figures be added to the drawings. It is noted that since the particular structure of the "spring biased teeth" and "spring biased pin" has not been set forth in the specification, it would appear that appropriate structure would constitute new matter unless applicant contends that the structure is old and well known in the art including an amendment to the specification stating such. The structure of old and well known "spring biased teeth" and a "spring biased pin" would need not be added to the drawings as such structure would be considered admitted prior art and obvious mechanical variants.

4. Newly submitted claims 19 and 20 are directed to a non-elected species. The elected embodiment included the species of figure 3. Figure 3 does not disclose a fastener supported by channels and does not disclose a lag screw. Claims 19 and 20 are directed to figure 11A.

Since applicant has received an action on the merits for the elected species, this species has been constructively elected by original presentation for prosecution on the

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merits. Accordingly, claims 19 and 20 are withdrawn from consideration as being directed to a non-elected species. See 37 CFR 1.142(b) and MPEP § 821.03.

It is further noted that applicant must include a listing of all claims readable on the elected embodiment when claims are subsequently added or the amendment will be considered non-responsive.

5. Claims are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1 and 17, it is not clear if applicant is claiming a pole apparatus or a pole apparatus in combination with a fastener since the preamble of the claim defines a pole apparatus and the body of the claim defines the combination of a pole apparatus and a fastener due to the positive recitation of "a fastener" supported on the tool. Since the preamble is directed to a pole apparatus and not the combination pole apparatus and fastener, the claims will be treated as defined by the preamble. Applicant must amend the preamble or the body of the claim to clearly define the invention.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 2, 7, 11, and 12-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over O (5,154,104) in view of Parsons (1,417,683).

Figure 12 of O discloses all of the claimed subject matter except for having a first connector with a tool removably mounted to the first connector, a ball lock, spring biased teeth, or a spring biased pin. Figure 12 of O discloses a one piece connector/tool "22" attached to a telescoping body. Parsons discloses a first connector removably attached to a telescoping body and a tool removably mounted by a quick disconnect system (spring biased pin) to the first connector. With respect to claims 2 and 7, Parsons further discloses a first connector with at least one alignment face and a hexagonal side wall. It would have been obvious to one having ordinary skill in the art to form the connector/tool of O as a first connector (with at least one alignment face and a hexagonal side wall) removably attached to a telescoping body and a tool removably mounted by a quick disconnect system (spring biased pin) to the first connector to allow for a quick disconnect between the tool and body as taught by Parsons.

The examiner takes Official Notice that the use of a ball lock, spring biased teeth, or a spring biased pin as a locking mechanism is notoriously old and well known in the art. Consequently, it would have been obvious to one having ordinary skill in the art to form the locking mechanism of Parsons as a ball lock, spring biased teeth or a spring biased pin as such are all old and well known mechanical equivalents.

8. Claims 18 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over O (5,154,104) in view of Smith, Yorde, or Osborn.

O discloses all of the claimed subject matter except for having perpendicular channels and a retainer ring. O discloses a connector 16', an elongate body 14', and a tool 22. Smith, Yorde, or Osborn disclose a tool having perpendicular channels and a

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retainer ring. It would have been obvious to one having ordinary skill in the art to form the tool of O with perpendicular channels and a retainer ring to grip a workpiece or tool as taught by Smith, Yorde, or Osborn.

9. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over O (5,154,104) in view of Parsons (1,417,683) as applied above, in further view of Smith, Yorde, or Osborn.

Smith, Yorde, or Osborn disclose a tool having perpendicular channels and a retainer ring. It would have been obvious to one having ordinary skill in the art to form the tool of O with perpendicular channels and a retainer ring to grip a workpiece or tool as taught by Smith, Yorde, or Osborn.

10. Applicant's arguments filed May 22, 2003 have been fully considered but they are not persuasive.

O discloses a tool for use in connection with the installation of ceiling-mounted elements. In response to applicant's argument regarding the installation of a "suspended" ceiling, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

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Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

11. Any inquiry concerning this communication should be directed to Debra S. Meislin at telephone number 703-308-3671.

A handwritten signature in black ink, appearing to read 'DM', with a long horizontal line extending to the right.

Debra S. Meislin
Primary Examiner
Art Unit 3723

7/1/03